

REMARKS

Claims 1-4, 6-15, 17-23, and 25-27 are currently pending in this application. An election of species and a further election of sub-species is contained in the February 24, 2004, Office action. As explained below, the undersigned requests reconsideration and withdrawal of the restriction/election.

There have been twenty-two or more claims pending in the application since its initial filing date.¹ On each review, the Office action has examined and considered these claims, rejecting or objecting to them based on its allegations. Now, in response to the amendments made in Applicant's last Response, to claims and general subject matter that have been pending for quite some time, the current Office action seeks to impose a restriction/sub-restriction

¹**Prosecution Chronology** - This application was originally filed on 1/17/01 with twenty-five claims. The first Office action of 2/27/02 examined and rejected all twenty-five of these claims. Some of them were amended by the Applicant and then all of them were re-examined in the next Office action, mailed 7/24/04, which was made final. An RCE and preliminary amendment, which amended several claims and withdrew claims 5, 16, and 24, were filed on 11/25/02. An Office action was mailed on February 28, 2003. This Office action examined the pending twenty-two claims, rejecting each one. The next Office action, mailed September 10, 2004, responded to the intervening response, and again examined and rejected or objected to the pending twenty-two claims. An amendment was filed on December 2, 2003, and the February 24, 2004, Restriction was mailed in response.

requirement, citing “the burden applicant is placing on the Examiner with the different patentably distinct species claimed.”

The Applicants’ last Response (December 2, 2003), amended twelve of the claims and added two new claims. The undersigned requests reconsideration of the restriction/election as the amendments entered in the Response must have been searched during the previous four examinations of the claims. For instance, the December 2, 2003, amendment to claim 1 added the language “the exterior surface of the first inflatable balloon at least partially covered with a therapeutic when the first balloon is in a partially unexpanded state.” By comparison, originally filed claim 2 reads “[t]he system for delivering therapeutic of claim 1 wherein the exterior surface of the first inflatable balloon is covered with a therapeutic.” Likewise, amended claim 20 reads “forcing a fluid into an expandable first membrane ... the expandable first membrane being juxtaposed to and replicating the irregular interior surface of the vessel of the patient.” While as-filed claim 20 reads “forcing fluids into the expandable-hyper-deformable membrane to expand the expandable hyper-deformable membrane, the ... membrane becoming juxtaposed to the irregular interior surface of the vessel of the patient.”

The undersigned further traverses the restriction/election requirement as the Office action lacks the required explanation. See MPEP § 803 (a mere statement of conclusion is inadequate). Moreover, as the past searches are surely to have encompassed the same classifications that are to be searched for the new language, this restriction is in disagreement with MPEP § 808.02, which provides that “[w]here ... the classification is the same and the field of search is the same

and there is no clear indication of separate future classifications and fields of search, no reasons exist for dividing among inventions.”

Nevertheless, to satisfy Applicant’s duty to respond, the undersigned hereby elects Figs. 6-7 and subspecies i. and further identifies claims 1-4, 6, 8-15, 19-23, 25-27 as being readable thereon.


CONCLUSION

The undersigned requests reconsideration of the election/restriction requirement.

The Examiner is invited to contact the undersigned to discuss any matter concerning this application.

Respectfully submitted,

Date: March 24, 2004


Fred T. Grasso
(Reg. No. 43,644)

KENYON & KENYON
1500 K Street, N.W., Suite 700
Washington, DC 20005
Tel: (202) 220-4200
Fax: (202) 220-4201